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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,168	08/28/2001	David B. Shaw	5628-06600	4655
7590	01/07/2004			
ERIC B. MEYERTONS CONLEY, ROSE & TAYON, P.C. P.O. BOX 398 AUSTIN, TX 78767-0398			EXAMINER SAMPLE, DAVID R	
			ART UNIT 1755	PAPER NUMBER

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/941,168	SHAW ET AL. 
	<b>Examiner</b>	Art Unit
	David Sample	1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 November 2003.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,5-19,21-33 and 55-57 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,5-19,21-33 and 55-57 is/are rejected.

7) Claim(s) 18 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                            4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20031103.                    6) Other:

## **DETAILED ACTION**

### ***Claim Objections***

Claim 18 is objected to because of the following informalities:

The next to last line of claim 18 contains an extraneous period. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

Claims 1 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The second line of claim 1 sets forth a general formula for the layered silicate. The general formula in claim 1 recites "8" silicon atoms and "a" magnesium atoms, where "a" is 4.75 to 5.45. From this formula, the ratio of silicon atoms to magnesium atoms must be 1.68 to 1.46 (i.e., 8/a or 8/4.75 and 8/5.75). If the ratio of Si/Mg atoms in the formula is 1.68 to 1.46, it is unclear how the SiO<sub>2</sub>/MgO ratio could be 2.20 to 2.40.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-19, 21-33 and 55-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Neumann (GB 1,432,770).

Neumann discloses a method of making a magnesium silicate, Example 2, which anticipates the method recited in claims 2, 3, and 5-17; and the steps recited in claims 18, 19, 21-33. See page 5, lines 5-25. First, solution 1 is formed by mixing magnesium sulfate, lithium sulfate and water. Id. Solution 3, containing a carbonate, is added to solution 1, and finally the mixture of solutions 1 and 3 are mixed with solution 4 (a silicate compound). Id. Applicants should also note Examples 3-29 which employ a process that is identical to the process described in Example 2.

Neumann discloses a composition for the magnesium silicate that is indistinguishable from the formula recited in claim 1. See col. 2, lines 12-23. Neumann fails to disclose the SiO<sub>2</sub>/MgO ratio in the examples (instant claims 1 and 18), the lithium content in weight percent of the examples (instant claims 1 and 18) or the rheological properties (instant claims 55-57). However, the product of Neumann is formed in a manner identical to the process described in the present claims. Therefore, the product recitations of instant claims 1, 18 and 55-57 are assumed to be inherent to the product of Neumann because the product of Neumann is produced in a manner identical to the presently claimed method. See MPEP 2112.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5-19, 21-33 and 55-57 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Sample whose telephone number is (572)272-1376. The examiner can normally be reached on Monday to Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (571)272-1362.



David Sample  
Primary Examiner  
Art Unit 1755